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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,718	01/22/2002	Brent D. Pemberton	1074-P-1	4244

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EXAMINER

HWANG, VICTOR KENNY

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,718

Applicant(s)

PEMBERTON, BRENT D.

Examiner

Victor K. Hwang

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


JEROME W. DONNELLY
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The amendment filed March 10, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the exercise apparatus having a durometer in the range of 40 to 50 (claims 4 and 9). The specification describes the apparatus as having a durometer in the range of 30 to 50 (page 6, line 6) or having a durometer of 40 plus or minus 5 (page 6, line 15), but not a durometer limited to the range of 40 to 50 as claimed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the limitation that the durometer of the apparatus be limited to the range of 40 to 50 as claimed. The specification describes the

apparatus as having a durometer in the range of 30 to 50 (page 6, line 6) or having a durometer of 40 plus or minus 5 (page 6, line 15), i.e. a durometer of 35 to 45.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Exer-Rings* (Flaghouse Special Populations, Spring 1995 catalog, pg. 81; and advertisement by Exerquipment Inc., The National Sports Daily, 12/10/90, pg. 31). *Exer-Rings* discloses a method of exercising a hand comprising the steps of providing a doughnut shaped, compressible, elastic exercise apparatus having a generally circular center line Y and a deformability which permits one portion of the apparatus to be rotated by the fingers while another portion of the apparatus is stationary. The apparatus can be grasped in the hand between the fingers and palm such that a first portion of the apparatus is grasped by the fingers and a second portion of the apparatus nests in the palm of the hand (see ad by Exerquipment Inc.). The fingers are moved to displace the first portion toward the second portion. The *Exer-Rings* apparatus includes a central opening having a diameter and includes a generally circular elastic ring circumscribing the opening and having a circular cross-sectional with a diameter.

Exer-Rings does not disclose the method wherein the fingers elastically rotate and twist the first portion about the centerline Y while the second portion generally remains nested in and

is prevented from rotating by the palm (claims 1 and 6); the cross-sectional area of the first portion of the apparatus reduced by less than 5% during step (c) (claims 2 and 7); the cross-sectional area of the first portion of the apparatus reduced by less than 20% during step (c) (claims 3 and 8); and the diameter of the central opening in the range of one and five-eighths to two and one-eighths inches and the diameter of the circular cross-section in the range of five-eighths to nine-eighths of an inch (claims 5 and 10).

One use of the *Exer-Rings* apparatus (Exerquipment ad) comprises the step of grasping the apparatus in the hand between the fingers and the palm such that a first portion of the apparatus is grasped by the fingers and a second portion of the apparatus nests in the palm of the hand. The first portion is displaced toward the second portion by moving the fingers while the second portion generally remains nested in and is prevented from rotating by the palm. Unless the force vector of the fingers is applied on the first portion of the apparatus in a direction that is directly toward the second portion and that inherently the movement of the fingers follow arcuate paths since the fingers are pivoted at the knuckles of the hand, the first portion of the apparatus will rotate and twist about the centerline Y when the fingers are moved to displace the first portion toward the second portion. During normal use of such an apparatus, it would be rare that the first portion is displaced toward the second portion without any rotation or twisting of the first portion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made that the first portion of the apparatus of *Exer-Rings* rotates and twists about the centerline Y when the first portion is displaced toward the second portion by movement of the fingers, since the force vectors of the fingers applied to the first portion would not always be

applied in a direction that is directly toward the second portion and since the fingers follow an arcuate path that would provide a torque to the first portion that would tend to rotate and twist the first portion such that the apparatus arches elastically into the upper portion of the palm and the lower portion of the each of the fingers.

Regarding the cross-sectional area reduced by less than 20% and less than 5%, the apparatus of *Exer-Rings* appears not to be reduced at all when the first portion is displaced toward the second portion. Therefore, the apparatus would satisfy the claimed step limitation.

Regarding claims 5 and 10, it would have been an obvious matter of design choice to provide the *Exer-Rings* with the central opening having a diameter in the range of one and five-eighths inches to two and one-eighth inches and the circular cross-section with a diameter in the range of five-eighths to nine-eighths of an inch, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

6. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Exer-Rings* (Flaghouse Special Populations, Spring 1995 catalog, pg. 81; and advertisement by Exerquipment Inc., The National Sports Daily, 12/10/90, pg. 31) as applied to claims 1 and 6 above, and further in view of *Sorbothane II* (Sorbothane II product brochure). *Exer-Rings* discloses the inventive method as claimed except for the apparatus having a durometer in the range of 40 to 50.

Sorbothane II discloses a compressible, elastic material for use in hand exercise devices. The material has a durometer of 20 to 70.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the apparatus of *Exer-Rings* of *Sorbothane II* material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. *Exer-Rings* fabricated of *Sorbothane II* material would have a durometer of 20 to 70, which would satisfy the claimed durometer range of 40 to 50.

7. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Exer-Rings* (Flaghouse Special Populations, Spring 1995 catalog, pg. 81; and advertisement by Exerquipment Inc., The National Sports Daily, 12/10/90, pg. 31) as applied to claims 1 and 6 above, and further in view of *Carlson* (US Pat. 3,265,389). *Exer-Rings* discloses the inventive method as claimed except for the apparatus fabricated from rubber.

Carlson discloses a compressible, elastic hand exercise apparatus 11. The apparatus is made of rubber or the like (col. 2, lines 7-10). Two methods are specifically disclosed for using the apparatus. The apparatus can be grasped between the fingers and palm of a hand with the fingers displacing an upper portion toward a lower portion (Fig. 1). The apparatus can also be grasped between the fingers and thumb and displacing the resulting upper portion toward the resulting lower portion, wherein the apparatus, as shown in Fig. 2, is arched or bowed toward the upper portion of the palm and the lower portion of the fingers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the apparatus of *Exer-Rings* of rubber, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. *Carlson* teaches the use of rubber for a compressible, elastic hand exercise apparatus.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Benji T. Gripster (Pemberton Enterprise LLC, webpage from benjigripster.com Internet website, 6/10/05) discloses the hand exercise apparatus made of natural rubber some time between 1993 and 2000 and shows the apparatus with respect to a user's hand. Presumably, the device shown is the same as the apparatus claimed. The arguments as applied to the *Exer-Rings* apparatus would apply as well to this device, in that the arcuate paths of the fingers and the imperfect force vectors of the fingers would cause the first portion of the device to rotate and twist about its centerline Y.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (571) 272-4976. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time.

The facsimile number for submitting papers directly to the examiner for informal correspondence is (571) 273-4976. The facsimile number for submitting all formal correspondence at this time is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on (571) 272-4887.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor K. Hwang
June 11, 2005

JEROME W. DONNELLY
PRIMARY EXAMINER

